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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 10/628,142
Filing Date: July 25, 2003
Appellant(s): HAASE, IGNATIUS XAVIER

David L. Hoffman
For Appellant

EXAMINER'S ANSWER

This is in response to the revised appeal brief filed 06/01/2009 appealing from the Office

action mailed 09/09/2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,623,679   RIVETTE et al.   4-1997

(9) Grounds of Rejection

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 5, 7-8, 13 and 17-20 are rejected under 35 U.S.C. 102(b) as being

anticipated by Rivette et al. (hereinafter Rivette, U.S. Patent No. 5,623,679 filed

04/18/1995, issued 04/22/1997).

In regard to independent Claim 1, <u>Rivette</u> discloses:

- *A method of encoding a document* (at least Title; Col. 4, lines 17-19 → ...

  creating an manipulating notes each containing multiple sub-notes, and linking

  the sub-notes to portions of data objects that are highlighted by the user),

  comprising the steps of:

  - o *identifying multiple characteristics about text of the document* (Fig. 37;

    Col. 36, line 40 through Col. 37, line 21→ a user can choose to annotate

portions of a document (words, sentences, paragraphs, etc.) by

highlighting those portions using a marker of a desired color by, for

example, "clicking" and "dragging" a mouse to highlight the portion. The

highlighting also creates a "color indicator" (542) in the margin with the

same color as that of the highlight). The user, in highlighting text in this

manner is interpreted to have *identified a characteristic about text of the*

document, as claimed. In addition, the "color indicator" is further identified

with a shape (square, triangle, and circle). Further, it is possible to overlap

highlights made on the same portion of text (Col. 37, lines 13-21) creating

multiple "color indicators" in the margin adjacent to the highlighted text.

Thus, the user can *identify <u>multiple</u> characteristics about text of the*

document in this way.

o *creating a key for correlating the multiple characteristics with multiple*

unique indicia (Figs. 11, 56, 62; Col. 41, lines 1-26 → selection of a patent

note icon downward arrow (127, Fig. 11) results in the display of a menu

(902) in Fig. 62 listing all patent notes which have been sorted according

to the specifications in the preferences dialog box 770 in Fig. 56. As

shown, the patent notes include various symbol icons in appropriate colors

as well as a numerical indicator of the patent note number.) This pull-down

menu is interpreted a *key* or legend to the "color indicators" in the margins.

As the user highlights more text, more entries are added to this pull-down

menu. Thus, the key or legend is "created" and added to in the process of
adding new highlights (and subsequently more notes).

- *placing at least some of the unique indicia adjacent at least some lines of
  text in the document* (see Fig. 37, items 540, 542 → highlight and
  corresponding "color indicator" in margin adjacent to the highlighted text),
  wherein

  - *the unique indicia placed adjacent each line of text correspond to
    the characteristic or characteristics in the line of text on the basis of
    the key* (see Fig. 37, items 540, 542; Col. 37, lines 13-21 →
    highlight and corresponding "color indicator" in margin adjacent to
    the highlighted text, and multiple, overlapping highlights and "color
    indicators" created),

wherein

  - *there is at least one line of text having at least two unique indicia
    adjacent thereto* (Col. 37, lines 13-21 → creating multiple "color
    indicators" in the margin adjacent to the highlighted text),

wherein

  - *in the steps of creating and placing the unique indicia comprise
    color-coded segments* (Col. 36, line 40 through Col. 37, line 21 →
    highlighting text produces a corresponding shaped, colored coded
    (Col. 36, lines 61-63) "color indicator" in the margin adjacent to the

text that was highlighted). A segment is interpreted as a single item

such as a single "color indicator"), *and*

- *the color-encoded segments are placed in a margin adjacent to and*

  in line with the text of the line (Figs. 37, 63, window labeled 160;→

  "color indicators" are seen in a margin adjacent to and in line with

  the text of the line)*, and*

wherein

- *there are at least some color-coded segments placed contiguously*

  with the same color-coded segments from adjacent lines of text and

  in a columnar arrangement perpendicular to the lines of text, so as

  to form contiguous segments of color-coding (at least Fig. 63,

  window labeled 160 → displays two triangles of the same color

  (actually lack of color in the Figure) placed "contiguously" and in a

  columnar arrangement perpendicular to the lines of text)*, and*

- *at least some lines of text have at least two characteristics and a*

  corresponding number of unique indicia in the margin adjacent the

  lines (at least Col. 37, lines 13-21; Figs. 37, 63 → multiple

  characteristics can be indicated for a line with a corresponding

  number of color indicators in a horizontal row adjacent to one

  another).

In regard to dependent Claim 3, <u>Rivette</u> discloses:

- *the document is stored on a digital medium* (Col. 3, lines 52-54; Col. 4, lines 17-19; Col. 15 line 65 through Col. 16, line 1 → equivalent files and image files reside on a hard disk drive or CD disk. Patent notes and sub-notes are stored in a database (Col. 42, line 35)), *and*

- *in the steps of creating and placing,*

  - *the key is stored on a digital medium* (Fig. 61, item 127; Col. 42, lines 39-63 → pull-down menu shows notes with corresponding indicia (shape icons and colors) that have been created so far. This feature represents a key which allows the user (by shape, color, and number) to distinguish between notes made). As the user adds highlighting and notes, the GUI keeps track (and likely stores) this information.

  - *the unique indicia are stored in a digital medium* (Col. 42, line 35, 39-63 → indicia are stored with notes/sub-notes which are stored in a database).

In regard to dependent Claim 5, <u>Rivette</u> discloses:

- *selectively changing the key by changing at least one of the color-coding and the characteristics* (Fig. 61, item 127; Col. 42, lines 39-63 → pull-down menu shows notes with corresponding indicia ("color indicators") that have been created so far. This feature represents a key which allows the user (by shape, color, and number) to distinguish between notes made). It is clear that if the user adds, removes, or makes other changes to the notes, that the pull-down menu (key)

would be altered to reflect the current state of the number, and type (color,

shape) of notes present in the content).

In regard to Claim 7, Claim 7 merely recites a system for performing the method

of Claim 1. Thus, <u>Rivette</u> discloses every limitation of Claim 7, as indicated in the

above rejection for Claim 1.

In regard to dependent Claim 8, <u>Rivette</u> discloses:

- *the memory comprises a digital recording medium* (see Fig. 1, items 25, 28);

- *processor* (see Fig. 1, items 8, 13, 20, 27);

- *selectively changing the key by changing at least one of the color-coding and the*

  characteristics (Fig. 61, item 127; Col. 42, lines 39-63 → pull-down menu shows

  notes with corresponding indicia ("color indicators") that have been created so

  far. This feature represents a key which allows the user (by shape, color, and

  number) to distinguish between notes made). It is clear that if the user adds,

  removes, or makes other changes to the notes, that the pull-down menu (key)

  would be altered to reflect the current state of the number, and type (color,

  shape) of notes present in the content).

In regard to Claim 13, Claim 13 merely recites an encoded document depicting

the method of Claim 1. Thus, <u>Rivette</u> discloses every limitation of Claim 13, as

indicated in the above rejection for Claim 1.

In regard to dependent Claim 17, <u>Rivette</u> discloses:

- *the characteristics of each line are stored in a digital recording medium* (Col. 3,
  lines 52-54; Col. 4, lines 17-19; Col. 15 line 65 through Col. 16, line 1; <u>Rivette</u>
  claims 1, 2 → equivalent files and image files reside on a hard disk drive or CD
  disk. Patent notes and sub-notes are stored in a database (Col. 42, line 35)).

- *there is a step of selectively placing a plurality of the unique indicia*
  corresponding to the multiple characteristics, based on the key, adjacent at least
  some of the lines of text (Fig. 37, items 540, 542 → upon highlighting text (540),
  a "color indicator" (542) is created in the margin of the document. Col. 36, lines
  13-21 provide for multiple "color indicators" being placed adjacent to the line of
  text and to one another).

In regard to dependent Claim 18, <u>Rivette</u> discloses:

- *a controller for enabling a user to select a plurality of the multiple characteristics,*
  and for changing the display based on the selection to show the unique indicia,
  which correspond to the selected multiple characteristics (Col. 41, lines 1-26;
  Figs. 60-63 → a graphical user interface that allows the user to create,
  manipulate, delete and otherwise alter notes and sub notes).

In regard to dependent Claim 19, <u>Rivette</u> discloses:

- *the document is stored on a digital medium* (Col. 3, lines 52-54; Col. 4, lines 17-19; Col. 15 line 65 through Col. 16, line 1; <u>Rivette</u> claims 1, 2 → equivalent files and image files reside on a hard disk drive or CD disk. Patent notes and sub-notes are stored in a database (Col. 42, line 35)).

In regard to dependent Claim 20, <u>Rivette</u> discloses:

- *storing the document on the digital recording medium* (see <u>Rivette</u> claims 1, 2 → means for storing patent document components and notes (and hence "color indicators" on media).

(10) Response to Argument

Argument A. Claim 1:

Appellant argues on page 8, lines 4-8 of the Brief, that the prior art of Rivette fails to teach all the elements of each of the claims, and in particular, (1) that it has the capability of putting multiple color-coded elements (shapes) in a margin adjacent the text, and also (2) has the capability of connecting so as to be contiguous, color-coded elements from adjacent lines of text.

The Examiner respectfully disagrees.

In response to argument (1) above, the Examiner cites features illustrated in at least col. 36, line 50 through col. 37, line 21 and Figures 37 and 63 of Rivette which

illustrate the generation of color-coded symbols (i.e. shapes such as circle, triangle,

etc.) in a margin adjacent to the text they reference (see window frame labeled 160

containing patent text lines labeled [73], [21], [22] and [52]). These symbols are created

when a user highlights a portion of the adjacent patent text (see Figure 37, items 540

and 542).

The purpose of highlighting portions of text and generating corresponding

symbols is to allow a user to add notes or annotations to further describe or

characterize the highlighted text, using the color-coded symbols to indicate that such

notes or annotations exist in the text line and to distinguish between multiple highlighted

text portions.

Rivette allows for the creation of multiple, even overlapping highlights for a given

patent text line producing multiple adjacent symbols (see col. 37, lines 13-21). Each of

the multiple highlights can be made with a different color producing a row of symbols of

different kinds and colors (note, symbol shape is another indicator of color for

monochrome displays).

Thus, Rivette teaches/discloses Appellants recited feature (1) above.

In response to argument (2) above, the Examiner again cites features illustrated

in at least col. 36, line 50 through col. 37, line 21 and Figures 37 and 63 of Rivette.

Specifically, as previously explained with respect to argument (1) above, Rivette allows

for the creation of multiple, even overlapping highlights for a given patent text line

producing multiple adjacent symbols (see col. 37, lines 13-21). Each of the multiple

highlights can be made with a different color producing a row of symbols of different kinds and colors.

Since a user can perform this function on a single line of patent text, then they can also implicitly (note: not illustrated by Rivette) perform it for multiple lines of text, even those which are consecutive. Performing this function on consecutive lines of patent text, such as that illustrated in at least Figures 37 and 63, would produce contiguous color-coded elements from adjacent lines of text, as in Appellant's argument (2).

Thus, Rivette teaches/discloses Appellants recited feature (2) above.

Appellant further argues (see pages 8-9 of Brief under section "Rivette Is a System For Creating and Manipulating Notes And Sub-Notes and Linking The Notes and Sub-notes To Text") that the overall purpose of Rivette's invention is to *"take a document image which cannot be searched and text that cannot be manipulated, and make it searchable and "manipulatable,"* using a highlight function to accomplish this, whereas their invention (1) is not for the creation of searchable and "manipulatable" document images, and (2) does not use highlighting to place color codes in the margin in columns so that one can place multiple colors adjacent text and understand the concepts (characteristics, e.g., protagonist speaking and climax) that are occurring in the story/text; the colors emphasizing a concept or concepts contained within the text line.

The Examiner respectfully disagrees.

It is noted that Appellant's claims are not directed to any specific purpose other than perhaps the steps involved in indicating characteristics present in a line of text using color-coded symbols.

As previously explained above, Rivette allows a user to create color-coded symbols to indicate characteristics (in this case, notes) are present in a line of text. The argument that Rivette's overall purpose and specific means to indicate characteristics of text via highlighting that produces color-coded symbols adjacent to text is irrelevant.

At the top of page 9 of Brief, Appellant alleges that Rivette's margin-placed color-coded symbol's color indicates a particular notation for its corresponding highlighted text portion, whereas Appellants invention's puts color codes in the margin in columns so that one can place multiple colors adjacent text and understand the concepts (characteristics, e.g., protagonist speaking and climax) that are occurring in the story/text. The colors thus emphasize the concept or concepts.

The Examiner respectfully disagrees.

In both Rivette and the Appellants invention, colored symbols are indicative of additional information associated with text portions to which they are adjacent. In Rivette, the additional information comprises notations about the highlighted text portion. In Appellant's invention, the additional information comprises "notations" of concepts.

Appellant alleges that unlike Rivette, in which the color coding is used to call up notes about the text, that their invention uses the color coding to intrinsically represent a characteristic of the text (see page 9, lines 17-18 of Brief).

The Examiner respectfully disagrees.

Rivette's color coded symbols do represent characteristics of the highlighted text to which they correspond. Each color is representative of a different characteristic within the corresponding text. Here, the characteristics are notes about the text.

Appellants further argue (see page 9, line 19 through page 10, line 7 of Brief) that there is absolutely no reason, suggestion, or common sense indication that one would make the color indicators run continuously down a column in the margin, it would defeat

the purpose of having a shape for each color indicator, and does not appear possible

given the drawing of Figure 37 of Rivette, and is speculative and hindsight based.

The Examiner respectfully disagrees.

As previously explained above, Rivette allows a user to generate multiple

symbols for a given line of text where those symbols would be aligned with each other

to form a row of symbols adjacent to the given line of paten text. If a user can perform

this function on a single line of patent text, then they can also implicitly (note: not

illustrated by Rivette) perform it for multiple lines of text, even those which are

consecutive. Performing this function on consecutive lines of patent text, such as that

illustrated in at least Figures 37 and 63 would implicitly produce contiguous, color-coded

elements from adjacent lines of text forming columns.

Appellant further argues (see page 10, lines 2-7 of Brief) that Rivette's Figure 63,

window 160, showing a square adjacent line "[73] Assignee: International Business

Machines, Armonk," showing triangles adjacent items [21] and [22], and showing a

blackened circle adjacent line [58] does not support the rejection. Rather, it shows

significant space between the color indicators (the square, each of the triangles and the

blackened circle). Smushing the color indicators together from adjacent lines would be

confusing, and would probably hinder the ability to link to the notes.

The Examiner agrees with this description of Figure 63 as showing significant space between color indicators as it does not illustrate symbols associated with consecutive lines.

However, Rivette also allows for the creation and placement of symbols on consecutive lines. Furthermore, <u>Rivette allows for the same symbol to occur on consecutive lines</u>. Rivette also allows for multiple symbols to occur for the same line. The notion of "smushing" color indicators together from adjacent lines leading to confusion in Rivette would not appear to be a problem in the case where consecutive lines contain the same symbol (hence color) forming a column.

Appellant further argues (see page 10, lines 8-15) that "The office action uses an impermissible obviousness to try standard." Specifically, that "the use of "can" and "could" and the general tenor of the rejection based on Rivette is essentially and "obviousness to try" rejection couched as an "inherency" argument in this section 102(b) rejection over Rivette."

The Examiner respectfully disagrees.

First and foremost, the Examiner's rejections are based on 35 U.S.C. 102(b) and not 35 U.S.C. 103(a). Therefore, longstanding patent law stating "That a patent claim

cannot be proved obvious merely by showing that the combination of elements was "obvious to try"" and KSR v. Teleflex, 550 U.S. 398, 82 USPQ2b at 1391 (2007) does not apply as it addresses 103-type rejections not 102.

Secondly, "in considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the *inferences which one skilled in the art would reasonably be expected to draw therefrom*" (emphasis added). In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). In other words, Rivette is relevant for all that it *expresses* and *implies* to one of ordinary skill in the art (e.g., a computer programmer who writes code for marking up text in electronic documents).

As indicated above, Rivette expressly teaches allowing a user to mark up any text within a document (e.g., a single line, two or more consecutive lines, two or more nonconsecutive lines, etc.) and attach any type of "note" to the marked up text. One of ordinary skill in the art would have readily recognized that user may mark up two or more consecutive lines with the same color and attach the same note to the marked up text to the lines of text. Actually, in the examiner's opinion, an **ordinary** computer user of the system disclosed in Rivette would have easily realized that he could: 1) markup multiple lines of text, each having multiple markups of different colors; and 2) markup two or more consecutive lines of text with the same color and attach the same note to those markups. Thereby, the user may markup the text "contiguously," as recited in Claim 1.

Moreover, the examiner points out that, throughout prosecution with respect to the 102 rejections based on Rivette, the examiner has never used the phrase "obvious to try" or the term "inherent" (or any variation thereof). Accordingly, any argument regarding an "obvious to try" rationale or an "inherency" rationale is not relevant to the 102 rejections based upon Rivette.

Argument B. Claim 7:

The invention as recited in claim 7 is a system for encoding and displaying a document. The same arguments set forth by Appellants with respect to claim 1 and the responses thereto by the Examiner are applicable to the system of claim 7.

Argument C. Claim 13:

The invention as recited in claim 13 is an encoded document of the type created by the process and system of claims 1 and 7, respectively. The same arguments set forth by Appellants with respect to claim 1 and the responses thereto by the Examiner are applicable to the encoded document of claim 13.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the

Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/James H. Blackwell/

08/26/2009

Conferees:

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